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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,373	01/12/2001	Akio Tanabe	P107156-00040	9467

7590 01/13/2005

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EXAMINER
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SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/758,373

Applicant(s)

TANABE ET AL.

Examiner

SHIBRU HELEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Drawings***

2. The drawings are objected to because in fig.2 step S28 'PEPRODUCE ASSOCIATED CUSTOM FILE' should be replaced by 'REPRODUCE ASSOCIATED CUSTOM FILE'. In the same figure step S22 'NUMERCAL' should be change to 'NUMERICAL'. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-8 and 10 are rejected under 35 U.S.C 102(e) as being anticipated by Uehara (US Pat. No.6118738).

Claims 6-10 will be discussed first.

Regarding **Claim 6**, Uehara discloses a recording medium playback apparatus for a recording medium playback system in which a first recording medium (see DVD folder of fig.1) having reproduction information recorded thereon and a second recording medium (see CD folder of fig.1) on which reproduction information and playback control information (see Read VMGI\_MAT, TT\_SRPT(A5) and read TOC(A6) of fig.3) for controlling a playback order of that reproduction information are recorded are both installable and which plays back said first and second recording media, said method comprising:

control means (see MP(207) of fig.1) for generating a custom file having said first recording medium alone registered therein (see fig.1 disk manager information memory device (300) and DVD reproduction system (205) and col. 5 lines 1-13 and col. 6 lines 1-6 ).

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playing back means (see DVD reproduction system (205) and CD reproduction system (206) of fig.1) for playing back said first and second recording media installed in said recording medium playback system in accordance with registered contents of said custom file (see fig.1 CD reproduction system (206), DVD reproduction system (205) and col.3 lines 59-67 and col. 6 lines 1-14).

Regarding **claim 7**, Uehara teaches that control means includes:

management table generating means (see READ VMGI-MAT TT-SRPT(A5) and READ TOC (A6)) for determining said type of a recording medium to be stored in said recording medium playback system and generates a management table including type information of said recording medium (col.6 lines 27-58); and

custom-file generating means (see write in memory device A7 of fig.3) for determining said type of said recording medium by referring to said management table upon reception of an instruction of registering said recording medium as said custom file, and registering said recording medium in said custom file to be assigned in association with said type (see fig.3 Identify disk type(A4), and col. 6 lines 59-67 and col. 7 lines 1-6) .

Regarding **claim 8**, Uehara teaches that when a recording medium registering instruction is issued during playback of said recording medium, said custom file generating means determines said type of said recording medium which is being played back by referring to said management table and registers said recording medium in said custom file to be assigned in association with said type ( see col. 8 lines 18-33 and 47-57).

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Regarding **claim 10**, Uehara teaches instruction receiving means for receiving an instruction of designating said custom file and said recording medium to be registered in said custom file (see fig. 4 set property to DVD mode (C1), identify disk physically (C2) Read manager information (C4) and fig. 45 set property to CD mode (D1), identify disk physically (D2), Read TOC(D4), and col. 6 lines 59-67 and col. 7 lines 37-42);

input receiving means for receiving an input of data about said custom file and said recording medium (see fig.21 and col. 13 lines 46-57 and lines 60-65);

means for checking if said designated recording medium matches with classification of said designated custom file by referring to said management table(see col.8 lines 3-16)

whereby said custom-file generating means registers said designating recording medium in said designating custom file when there is a match (see col. 8 lines 3-9).

Regarding **Claims 1-3 and 5**, these claims are method claims corresponding to apparatus claims 6-8 and 10, respectively. Therefore, claims 1-3 and 5 are analyzed and rejected as previously discussed with respect to claims 6-8 and 10.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uehara '738 in view of Yamauchi et al. (USPN 6,020,982).

Claim 9 will be discussed first. Regarding **claim 9**, Uehara teaches instruction receiving means for receiving an instruction of designating said custom file and said recording medium to be registered in said custom file (see fig. 4 set property to DVD mode (C1), identify disk physically (C2) Read manager information (C4) and fig. 45 set property to CD mode (D1), identify disk physically (D2), Read TOC(D4), and col. 6 lines 59-67 and col. 7 lines 37-42). However, Uehara fails to teach menu display means for displaying a selection menu for custom files where registration is to be made to thereby prompt a user to select one of said custom files and list display means for displaying a list of those of recording media stored in said recording medium playback system, which are registrable by referring to said management table.

In the same field of endeavor, Yamauchi teaches a recording playback apparatus (Fig. 1, machine 600) in which a first recording medium (Fig. 1, cards 811/400, unit 500, or VTRs 807/808) having reproduction information recorded thereon and a second recording medium (Fig. 1, cards 811/400, unit 500, or VTRs 807/808) having reproduction information recorded thereon. Yamauchi further teaches menu display means for displaying input sources to thereby prompt a user to select one of said input sources and list display means for displaying a list of those of recording media stored in said recording medium playback system (see Figs. 88-90; col. 4 line 33 – col. 5 line 10; col. 51 line 34 – col. 52 line 38). In light of the teaching from Yamauchi, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the recording medium playback apparatus disclosed by Uehara menu

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display means and list display means as claimed in order to allow a user to monitor at a glance which recording medium is currently played back

Regarding **claim 4**, this claim is a method claim corresponding to the apparatus 9.

Therefore, claim 4 is analyzed and rejected as previously discussed with respect to claim 9.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tajiri (US Pat. No. 6072757) discloses an apparatus and a method for determining a disc type. Park (US Pat. No. 5683253) discloses two reproducers in a disc-recording medium.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIBRU HELEN whose telephone number is 703 305 0637. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary Ngoc-Yen Vu can be reached on 703-305-4946. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru  
01/10/2005



NGOC-YEN VU  
PRIMARY EXAMINER